

REMARKS/ARGUMENT

Claims 2-9, 11-16, and 18-23 are pending in the application. The Examiner issued a final rejection of Claims 2-19, 11-16, and 18-23. In this Amendment, Applicant amends Claims 2-9, 11-16, and 18-20. Applicant cancels Claims 4, 21, 22, and 23 without prejudice to Applicant in the process of rewriting the same. Applicant adds Claims 24-29 to claim his invention as broadly as the prior art will allow. Applicant respectfully requests reconsideration of Claims 2, 3, 5-9, 11-16, 18-20, and 24-29 for the reasons set forth below. Applicant respectfully requests that the Examiner reconsider each rejection in light of the foregoing amendments to the claims and the following remarks and argument.

The Examiner has also objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they include reference signs not mentioned in the description. Applicant encloses herewith two (2) copies of corrected drawings in red ink.

Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected Claims 2, 6 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,601,260 to Shinohara, *et al.*, hereinafter "Shinohara." Applicant cancels Claim 21 and adds Claim 24. Applicant amended Claims 2 and 6 so that they depend from Claim 24.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single reference (citations omitted). The identical invention must be shown in as complete detail as contained in the . . . claim (citations omitted). The elements must be arranged as required by the claim. MPEP § 2131.

Contrary to the Examiner's statement that all claims are disclosed in the Shinohara reference, the foot plate and earth anchor portion is not, and the rejection of new Claim 24 under §102(b) is unsupported by the reference, and it should be withdrawn.

Since Claims 2 and 6 now depend from Claim 24, Shinohara will not support a § 102(b) rejection of Claims 2 and 6 as being anticipated by Shinohara, and the rejections should be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

To make a *prima facie* case for obviousness under 35 U.S.C. § 103, the Examiner must show: (1) some suggestion or motivation in the prior art reference(s) or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings to meet the claimed invention; (2) a reasonable expectation of success for the modification or combination of the prior art references; and (3) the prior art references teach or suggest all of the claim limitations of the claimed invention. MPEP § 2143.

The mere fact that references *can be* combined does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination MPEP § 2143.01. Citing references which merely indicate that isolated elements and/or features recited in the claims are individually known in the art or that the elements would have been well within the ordinary skill of the art at the time the invention was made is not a sufficient basis for concluding that the combination of claimed elements would have been obvious, absent objective evidence of a motivating force which would compel persons skilled in the art to do what Applicant has done. *See Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993); *Ex parte Hiyamizu*, 10 U.S.P.Q. 2d 1393 (Bd. App. & Inter. 1988). A combination is improper where an Examiner's

proposed modification would render the prior art version unsatisfactory for its intended purposes. *See Ex parte Rosenfield*, 130 U.S.P.Q. 113 (Bd. Pat. App. 1961).

An obviousness rejection is valid only if (i) it would have been obvious to a person of ordinary skill in the art to modify the structure that the primary reference discloses to that structure which is claimed, as a matter of standard design technique if the reference stands alone or as a result of a combination of one or more secondary references if the primary reference teachings missing from the primary reference; (ii) any modification or combination is motivated or suggested by the primary reference; (iii) each and every limitation is taught by the modified or combined prior art; and (iv) such modifications or combinations do not require an inventive step.

The Examiner rejected Claims 3, 5, 7, and 8 under 35 U.S.C. §103(a) as being unpatentable over Shinohara. Shinohara will not support an obviousness rejection of Claim 3 under §103(a). Shinohara does not disclose the foot plate and earth anchor portion of Claim 24 or the separator post as claimed in Applicant's Claim 3. The Shinohara reference does not teach or suggest the modification of adding a separator post. Shinohara does not support an obviousness rejection of Claim 3 under §103(a), and it should be withdrawn.

Claim 5 depends from Claim 24 and adds the limitation of color. Because Shinohara does not disclose, suggest, or teach the foot plate and earth anchor portion, Claim 24 is not anticipated by Shinohara. Shinohara will not support an obviousness rejection of Claim 5. The Examiner has not provided any support for the conclusion that it would have been obvious to one skilled in the art to color-code the wire separator apparatus depending on the type of utility conduit to which the wire separator apparatus is attached. Shinohara does not support an obviousness rejection of Claims 5 under §103(a), and it should be withdrawn.

Claims 7 now depends from Claim 24 and further limits the conduit clamp opening from sixty to eighty degrees from the centerline of the main conduit. As shown above, Shinohara does not support an obviousness rejection of Claim 24. Shinohara teaches a clamping means that requires a hole to be made in the mounting plate (the conduit in the disclosed invention) and the clamping means being inserted into that hole. The disclosed invention provides for a conduit clamp that binds the insulating wire separator apparatus to the conduit without having to make a hole in the conduit. Shinohara teaches away from the disclosed invention because one skilled in the art would not have thought to provide a hole in a conduit used to transport fluids and/or natural gas. Shinohara does not support an obviousness rejection of Claims 7 under §103(a), and it should be withdrawn.

Claim 8 now depends from Claim 24 and adds the additional limitation of the tracer wire guide being angled from three to thirty degrees from the centerline of the arm portion, to engage varying sizes of tracer wire. Shinohara does not teach or suggest angling the tracer wire guide to secure tracer wires of varying sizes. The Examiner has not supported the conclusion that it would have been obvious to one skilled in the art at the time of the invention to angle the tracer wire guides as disclosed by Applicant. Shinohara does not support an obviousness rejection of Claim 8 under §103(a), and it should be withdrawn.

The Examiner rejected Claim 9 under § 103(a) as being unpatentable over Shinohara in view of Adams. Claim 9 depends from Claim 24 adding the limitation of the main conduit receiving portion comprising an inner radius having a first half portion, with a second half portion releasably secured to said first half portion with a releasable fastener.

The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to

include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the items secured therein as taught by Adams. The Examiner has not shown any suggestion or motivation to modify Shinohara to include a conduit clamp having two radiused portions releasably fastened together. Shinohara disclosed a fastening means that attaches to a mounting plate by inserting the fastening means into a hole in the mounting plate and not by clamping around the outside circumference of the conduit. Shinohara in view of Adams does not support an obviousness rejection of Claim 9 under § 103(a), and it should be withdrawn.

The Examiner rejected Claims 4, 11-15, 19, 20, 22, and 23 under § 103(a) as being unpatentable over Shinohara in view of Ziu. Claim 4 has been canceled without prejudice to Applicant. The Examiner recognizes that Shinohara does not disclose the main conduit receiving portion including the strengthening rib. Ziu discloses an alternate support for mounting an inner carrier pipe within an outer containment pipe. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the wire support of Shinohara by including an outer rib because one would have been motivated to provide a stronger gripping support as taught by Ziu.

Applicant canceled Claims 22 and 23 and added Claims 24 and 25. Claim 24 provides an insulating wire separator apparatus for separating a tracer wire a safe distance from a main conduit in a trench prior to backfilling, which comprises: (a) a resilient, main conduit receiving portion having an inner radius sized to receive a main conduit portion therein, an opening sized to flex about said main conduit, and an outer strengthening rib; (b) an arm portion extending away from the main conduit receiving portion on a side opposite said opening in the main conduit receiving portion, said arm portion extending a safe distance beyond said main conduit

receiving portion; (c) a foot plate and earth anchor portion extending at right angles from said arm portion in proximity to said conduit receiving portion; and (d) a tracer wire clip portion having a pair of guides for receiving a tracer wire therein, said tracer wire clip portion positioned on the arm portion at an end opposite the main conduit receiving portion, to position the tracer wire a safe distance from the existing main conduit to protect the conduit from becoming damaged or melted.

As shown above, Shinohara does not disclose the foot plate and earth anchor portion of Claim 24. Adams discloses no such foot plate and earth anchor portion. The references cited do not teach each and every limitation of Claim 24. Shinohara as view of Ziu will not support an obviousness rejection of Claims 24, or any claim depending there from.

Claim 25 provides an insulating wire separator apparatus for separating a tracer wire a safe distance from a main conduit in a trench prior to backfilling, which comprises: (a) a resilient, main conduit receiving portion having an inner radius sized to receive a main conduit portion therein, an opening size to flex about said main conduit, and an outer strengthening rib; (b) an arm portion extending away from the main conduit receiving portion on a side opposite said opening in the main conduit receiving portion, said arm portion extending a safe distance beyond said main conduit receiving portion; (c) a foot plate and earth anchor portion extending at right angles from said arm portion in proximity to said conduit receiving portion, to facilitate attaching the insulating wire separator apparatus to a main conduit and to resist rotation of the wire separator apparatus around the circumference of the conduit; and (d) a tracer wire clip portion having a pair of fingers for receiving a tracer wire therein, said tracer wire clip portion positioned on the arm portion at an end opposite the main conduit receiving portion, to position

the tracer wire a safe distance from the existing main conduit to protect the conduit from becoming damaged or melted.

Shinohara does not disclose the foot plate and earth anchor portion or the outer strengthening rib of Claim 25. Adams does not disclose the foot plate and earth anchor portion or the outer strengthening rib. The references cited do not teach each and every limitation of Claim 25. Shinohara in view of Ziu will not support an obviousness rejection of Claim 25, or any claim depending there from.

Claim 11 now depends from Claim 27 adding the limitation that the arm portion extends at least about two inches beyond the separator post to provide safe spacing for additional underground utilities in a common trench. Because Shinohara in view of Ziu will not support an obviousness rejection of Claim 27, and Claim 11 depends from Claim 27, Shinohara in view of Ziu will not support an obviousness rejection of Claim 11 under 35 U.S.C. § 103(a), and it should be withdrawn.

Claim 13 now depends from Claim 25 adding the limitation that the tracer wire clip portion is located at the distal end of the arm portion. Because Shinohara in view of Ziu will not support an obviousness rejection of Claim 25, and Claim 13 depends from Claim 25, Shinohara in view of Ziu will not support an obviousness rejection of Claim 13 under 35 U.S.C. § 103(a), and it should be withdrawn.

Claim 14 now depends from Claim 25 adding the limitation that the opening provided in the resilient, main conduit receiving portion is from sixty to eighty degrees from the centerline of the main conduit. Because Shinohara in view of Ziu will not support an obviousness rejection of Claim 25, and Claim 14 depends from Claim 25, Shinohara in view of Ziu will not support an obviousness rejection of Claim 14 under 35 U.S.C. § 103(a), and it should be withdrawn.

Claim 15 now depends from Claim 25 adding the limitation that the tracer wire clip guide portion is angled from three to thirty degrees from the centerline of said arm portion to engage varying sizes of tracer wire therein. Because Shinohara in view of Ziu will not support an obviousness rejection of Claim 25, and Claim 15 depends from Claim 25, Shinohara in view of Ziu will not support an obviousness rejection of Claim 15 under 35 U.S.C. § 103(a), and it should be withdrawn

The Examiner rejected Claims 16 and 18 as being obvious over Shinohara in view of Ziu and in view of Adams. Claim 16 now depends from Claim 25 and Claim depends from Claim 24. Claims 16 and 18 add the limitation that the main conduit receiving portion comprises an inter radius having a first half radius portion, with a second half radius portion releasably secured to said first half portion with a releasable fastener.

The Examiner conceded that Shinohara in view of Ziu does not teach the main conduit receiving portion comprising a first and second half radiused portions, but concluded such a structure is suggested by Adams. Adams discloses a means for adjusting the position of the item secured therein. The disclosure in Adams, however, corresponds to the wire clip portion of Applicant's invention, it does not relate to the main conduit receiving portion. These references do not suggest the desirability of the combination. Citing references that merely indicate the isolated elements recited in the claims are individually known or that the elements would have been well within the ordinary skill of the art at the time of the invention is not a sufficient basis for concluding that the combination of claimed elements would have been obvious., without objective evidence of a motivating force which would compel persons skilled in the art to do what Applicant has done. Shinohara in view of Ziu and further in view of Adams will not

support an obviousness rejection of Claims 16 and 18 under 35 U.S.C. § 103(a), and they should be withdrawn

Claim 19 now depends from Claim 26, adding the limitation that the tracer wire clip guide portion is angled from three to thirty degrees from the centerline of said arm portion to engage varying sizes of tracer wire therein. Because Shinohara in view of Ziu will not support an obviousness rejection of Claim 26, and Claim 19 depends from Claim 26, Shinohara in view of Ziu will not support an obviousness rejection of Claim 19 under 35 U.S.C. § 103(a), and it should be withdrawn.

The Examiner rejected Claims 12 and 20 as being obvious over Shinohara in view of Ziu. The Examiner concluded that it would have been obvious to modify the wire support to be of various colors because one would have been motivated to provide a device that is aesthetically pleasing. Again, neither Shinohara nor Ziu teach a separator post extending at right angles from said arm or extension portion, with the separator post being spaced at least 10 inches from the foot plate and earth anchor portion portion.

Claim 12 now depends from Claim 25 adding the limitation that the insulating wire separator apparatus is color-coded with a separate color used for each utility. Claim 20 now depends from Claim 26 adding the limitation that the insulating wire separator apparatus is color-coded with a separate color used for each utility. The Examiner has not provided any support for the conclusion that it would have been obvious to one skilled in the art to color code the wire separator apparatus depending on the type of utility conduit to which the wire separator apparatus is attached. Shinohara does not support an obviousness rejection of Claims 12 and 20 under §103(a) and it should be withdrawn.

For all of the reasons above given, Applicant believes that all of the claims patentably distinguish Applicant's invention from all of the prior art cited or applied, whether applied individually or in combination with each other. Applicant respectfully solicits a prompt issuance of a Notice of Allowance.

Respectfully submitted,

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IM-452014_2.DOC